

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JON D. KITTELSEN

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Appeal No. 1999-2625  
Application 08/763,929<sup>1</sup>

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ON BRIEF

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Before STAAB, McQUADE and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jon D. Kittelsen appeals from the final rejection of claims 1 through 13, 15 and 17 through 20, all of the claims

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<sup>1</sup> Application for patent filed December 12, 1996. According to the appellant, the application is a continuation-in-part of Application 08/689,253, filed August 5, 1996, now U.S. Patent No. 5,836,761, issued November 17, 1998.

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pending in the application.<sup>2</sup> We reverse.

The invention relates to "a one-piece customizable dental appliance for use by athletes" (specification, page 1). A copy of the claims on appeal appears in the appendix to the appellant's main brief (Paper No. 11).<sup>3</sup>

The references relied upon by the examiner as evidence of anticipation and obviousness are:

Ross 6, 1958	2,833,278	May
Lerman 1970	3,532,091	Oct. 6,
Kittelsen et al. (Kittelsen) 18, 1990	4,977,905	Dec.
Poterack 1995	5,386,821	Feb. 7,

Claims 1 through 13, 15 and 17 through 20 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

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<sup>2</sup> Claims 1 and 13 have been amended subsequent to final rejection.

<sup>3</sup> Claims 13 and 15 appear to be substantial duplicates of claims 2 and 5, respectively. Attention is directed to MPEP § 706.03(k).

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Claims 1, 6 and 8 through 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ross.

Claims 1, 6 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Poterack.

Claims 1 through 10, 13, 15 and 17 through 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ross in view of Kittelsen and Poterack.

Claims 11, 12 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ross in view of Kittelsen and Poterack, and further in view of Lerman.

Reference is made to the appellant's main and reply briefs (Paper Nos. 11 and 13) and to the examiner's answer (Paper No. 12) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

Turning first to the 35 U.S.C. § 112, second paragraph, rejection, the examiner considers claims 1 through 13, 15 and 17 through 20 to be indefinite because

[i]n the two independent claims 1 and 13, lines 10 and 11, it is unclear how a single "wall" and a

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"base" can form the claimed "channel." Insufficient structure is set forth to support the "channel" limitation. Moreover, applicant's use of the terminology "channel" to describe a structure (referred to as 187 in Figures 14-20) having a base (174) and only a single side (182) is an unreasonable distortion of the common meaning of the term "channel." [examiner's answer, page 3].

As appreciated by the examiner, the recitation in claims 1 and 13 of a base and a labial wall which together define a channel reads on the appellant's disclosure of base 174 and labial wall 182 which together define channel 187 (see, for example, specification page 14 and drawing Figures 16 and 23). Even though it is composed of a base and but a single side wall, structure 187 falls within the ordinary and accustomed meaning of the term "channel" ("a trench, furrow, or groove") which has been proffered by the appellant (see page 4 in the main brief) and accepted by the examiner (see page 3 in the answer). Thus, the examiner's concern about the definiteness of the channel limitations in claims 1 and 13 is unfounded.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claims 1 through 13, 15 and 17 through 20.

As for the 35 U.S.C. § 102(b) rejections, while both Ross

and Poterack disclose dental appliances, the respective appliances have somewhat dissimilar constructions and functions.

Ross pertains to "protective mouthpieces for preventing injury to the user" (column 1, lines 15 and 16). The embodiment 40 relied upon by the examiner (see Figures 10 through 14) includes two resilient H-shaped channel members 41a and 41b and a resilient labial band 42 connecting the anterior portions of the channel members. In use, the channel members fit over and about the upper and lower posterior teeth and the connecting band lies over the front surfaces of the upper anterior teeth.

Poterack relates to "bite blocks for intubated patients in which the compressive force resulting from the closure of the jaws is borne by the molars" (column 1, lines 6 through 8). Poterack's bite block 10 includes left and right wedges 12a and 12b and a U-shaped rib 14 connecting the anterior portions of the wedges. As best seen in Figures 2 and 8, the rib extends forwardly at an inclined angle relative to the plane of the wedges. In use, the wedges lie between the

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patient's upper and lower posterior teeth and the rib fits snugly over the front surfaces of the upper or lower front teeth. The inclination of the rib provides clearance between the upper and lower teeth to accommodate the insertion and positioning of endotracheal tubes or the like.

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The examiner's determination that both Ross and Poterack disclose each and every element of the invention recited in independent claim 1 (see pages 4 and 5 in the answer) is not well taken.

Claim 1 requires the dental appliance recited therein to comprise, inter alia, a pair of pads each having a base and a labial wall extending downward from the base with the base and wall together forming a channel to receive the posterior teeth of the lower jaw, and a band having posterior ends connecting the pads and extending forwardly and downwardly along the lower jaw anterior teeth. Ross does not meet the claim

limitations relating to the band. Although Ross' band 42 extends forwardly when in use, it does not do so at any inclination (i.e., downwardly). Poterack does not meet the claim limitations relating to the pad channels. Although Poterack's wedges arguably constitute pads, they do not define "channels" within any reasonable definition of this term.

Since neither Ross nor Poterack meets each and every element set forth in claim 1, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 1 and dependent claims 6 and 8 through 10 as being anticipated by Ross or the standing 35 U.S.C. § 102(b) rejection of claim 1 and dependent claims 6 and 9 as being anticipated by Poterack.

We also shall not sustain the standing 35 U.S.C. § 103(a) rejections of claims 1 through 13, 15 and 17 through 20.

As explained above, neither Ross nor Poterack meets both the band and channel limitations in independent claim 1. Claim 13, the other independent claim on appeal, contains identical limitations which are similarly unmet by either reference. Apparently recognizing that such might be the case notwithstanding the above noted § 102(b) rejections, the

examiner has rejected claims 1 and 13, as well as the claims depending therefrom, under 35 U.S.C. § 103(a) based on the fundamental rationale that "Poterack (column 4, lines 37-40) teaches that the band may be formed to fit snug along the patient's lower jaw; to have formed the Ross Figure 10 band in the manner taught by Poterack would have been obvious to one of ordinary skill in the art" (answer, page 6). Presumably, this modification would provide Ross' band with the inclination required by claims 1 and 13. While Poterack's band or rib 14 is indeed inclined to fit snugly against the upper or lower front teeth, the inclination is necessitated by the particular relationship between the pads or wedges 12a and 12b of Poterack's bite block and the patient's teeth and the need to provide a clearance between the upper and lower teeth to accommodate intubation (see Figure 8). The relationship between Ross' pads or channel members 41a and 41b and the teeth differs from that disclosed by Poterack and results in Ross' band 42 overlying the front teeth without the need for any inclination. In this light, it is not evident why one of ordinary skill in the art would have found any suggestion or

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motivation in the combined teachings of Ross and Poterack to make the modification proposed by the examiner. This flaw in the examiner's basic reference combination finds no cure in Kittelsen's disclosure of a protective mouthpiece having cut lines to facilitate customized fitting and/or in Lerman's disclosure of a protective mouthpiece having cushioning and shock dissipation chambers therein.

In summary and for the above reasons, the decision of the examiner to reject claims 1 through 13, 15 and 17 through 20 is reversed.

REVERSED

LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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